

REMARKS

I. Status of the Application

Claims 1-31 are pending in this application. In the January 19, 2005 Office action, the examiner noted that Figure 1 of the drawings should be amended. In addition, the examiner allowed claims 8-12. The examiner rejected claims 1, 2, 13-16, 21-23 and 29-31 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. patent No. 4,060,457 to Iizuka et al. ("Iizuka"). Finally, the examiner objected to claims 3-7, 17-20 and 24-28 as being dependent upon a rejected base claim, but noted that claims 3-7, 17-20 and 24-28 would be allowable if re-written in independent form.

In this response, applicants have proposed a drawing correction. With respect to the claims, applicants respectfully traverse the examiner's rejection of claims 1, 2, 13-16, 21-23 and 29-31 under 35 U.S.C. § 103(a). In addition, Applicants have amended claim 21 to overcome the examiner's rejection of that claim. Finally, applicants have added new claim 32.

II. The Objection to the Drawings Should be Withdrawn

In the January 19, 2005 office action, the examiner noted that Figure 1 of the drawings should be designated by a legend such as "Prior Art" pursuant to MPEP § 608.02(g). Attached hereto is a replacement sheet of drawings which shows revised Figure 1, including the legend "Prior Art". The attached replacement sheet is labeled "Replacement Sheet" in the header, pursuant to 37 CFR § 1.121.

III. The Rejection of Claims 1, 13 and 21 should be Withdrawn

In the January 19, 2005 Office action, the examiner rejected claims 1, 13 and 21 under 35 U.S.C. § 103(a) as being obvious and unpatentable over Iizuka. Applicants respectfully traverse the examiner's rejection of claims 1, 13 and 21 under 35 U.S.C. § 103(a), as the examiner has failed to make a *prima facie* case of obviousness as described in MPEP § 2142 - 2143.

A. All Claim Limitations Must be Taught or Suggested by the Prior Art

In order to make a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. In this case, applicant submits that at least one limitation from each of claims 1, 13 and 21 is not suggested or taught by the prior art.

For example, with respect to claims 1, 13 and 21 Applicant submits that at least the limitation that the tip rack comprises an "electrically conductive plastic material" is not disclosed in Iizuka. In the January 19, 2005 Office action, the examiner stated that the "tube holder used in [Iizuka] may be made of glass, metals, plastics or composite of these materials". The examiner then stated that "it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that a composite of metal and plastic may be considered an electrically conductive plastic material". Applicant respectfully traverses this conclusion by the examiner. In particular, there is no disclosure in Iizuka of any "electrically conductive plastic material." The mere fact that a composite of plastic and metal could comprise electrically conductive plastic material is not a disclosure of such an electrically conductive plastic material. To hold otherwise

would invalidate numerous existing patents. For example, the use of two elements to make a compound may be known, but a particular ratio of the two elements may provide unique advantages. The mere fact that such elements could have been combined in this ratio before does not make the particular ratio obvious and unpatentable. Likewise, in the present case, there is no suggestion or motivation in the art cited by the examiner for one of ordinary skill in the art to conclude that the tube holder of Iizuka should be electrically conductive composite material.

As another example that all claim limitations in the present case are not taught or suggested by the prior art, claim 1 calls for a tip rack having a face and “at least one sidewall ... comprised of an electrically conductive plastic material”. A close reading of Iizuka reveals that there is no disclosure of “at least one sidewall ... comprised of an electrically conductive plastic material.” In particular, Iizuka discloses an apparatus comprising a tube holder including an upper panel 1 and a lower panel 2 placed within a box reservoir 4. (See col. 1, lines 54-59). The tube holder, which comprises panels 1 and 2, is disclosed as being “made of glass, metals, plastics or composite of these materials”. (See col. 2, lines 40-42 of Iizuka). The box reservoir 4 is “made of glass or plastics”. (See col. 2, lines 46-48). Only the tube holder comprising an upper panel 1 and a lower panel 2 is disclosed as being comprised of a plastic and metal composite. There is no disclosure that the box 4 is comprised of a composite of metal and glass. Accordingly, Iizuka does not disclose “at least one sidewall ... comprised of an electrically conductive plastic material,” as required by claim 1.

As another example, amended claim 21 includes the limitation of “a plurality of seats designed and dimensioned to hold pipette tips.” In the January 19, 2005 Office

action, the examiner stated that “the structure of applicant’s invention does not limit it from being capable of holding test tubes.” However, the device of Iizuka is clearly not “designed and dimensioned” to hold pipette tips, as the pipette tips would likely fall through the holes of the upper and/or lower panel and not be held within any seat disclosed in Iizuka. Instead, the device of Iizuka is designed and dimensioned to hold test tubes at a particular orientation.

As yet another example, amended claim 21 includes the limitation of a “plurality of seats ... comprised of an electrically conductive plastic material operable to discharge static electricity deposited on the pipette tips through the tip rack when the pipette tips contact the tip rack.” As discussed above, there is no disclosure in Iizuka of an electrically conductive plastic material operable to discharge static electricity through a tip rack when tips are place on the rack.

For at least the reasons discussed above, the examiner has failed to make a *prima facie* case that claims 1, 13 and 21 are unpatentable over Iizuka. Accordingly, it is respectfully submitted that claims 1, 13 and 21 are allowable and the examiner’s rejection of claims 1, 13 and 21 as obvious over Iizuka under 35 U.S.C. § 103(a) should be withdrawn.

B. The Prior Art Teaches Away

When the prior art teaches away from the claimed invention, there is a suggestion of a lack of *prima facie* obviousness. MPEP § 2145; See In re Fine, 873 F. 2d 1071 (Fed. Cir. 1988). In the present case, the examiner has cited Iizuka as disclosing a tube holder that “may be made of glass, metals, plastics or composite of these materials”. The examiner

then states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to recognize that a composite of metal and plastic may be considered an electrically conductive plastic material". However, a closer reading of Iizuka reveals that the apparatus disclosed comprises a tube holder including an upper panel 1 and a lower panel 2 placed within a box reservoir 4. (See col. 1, lines 54-59). The tube holder, which comprises panels 1 and 2, is disclosed as being "made of glass, metals, plastics or composite of these materials". (See col. 2, lines 40-42 of Iizuka). The box reservoir 4 is "made of glass or plastics". (See col. 2, lines 46-48). Only the tube holder comprising an upper panel 1 and a lower panel 2 is disclosed as being comprised of a plastic and metal composite. There is no disclosure that the box 4 is comprised of a composite of metal and glass. Without some discussion of a specific dissipative material, ground connection, or other means to allow the tube holders 1 and 2 to discharge static by virtue of some particular material or method, the Iizuka reference seems to teach that the tube holders 1 and 2 are insulated by the non-conducting box reservoir 4. In short, a closer examination of the disclosure in Iizuka suggests creation or insulation of static charges, not dissipation of static charges. This teaches away from applicant's claimed invention. Significant additional disclosure would be required for Iizuka to teach what is claimed in the present case. Accordingly, because the prior art teaches away from the claimed invention, it is respectfully submitted that the examiner has failed to make a prima facie case of obviousness, and the rejection of claims 1, 13 and 21 under 35 U.S.C § 103(a) should be withdrawn.

IV. The Rejection of Claims 2, 14-16, 22-23 and 29-31 Should be Withdrawn

As stated above, the rejection of claims 1, 13 and 21 under 35 U.S.C § 103(a) should be withdrawn. Each of claims 2, 14-16, 22-23 and 29-31 depend from and incorporate all of the limitations of one of claims 1, 13 or 21. Accordingly, it is respectfully submitted that the examiner's rejection of claims 2, 14-16, 22-23 and 29-31 should also be withdrawn.

V. Conclusion

For all of the foregoing reasons, it is respectfully submitted that the examiner has not made a *prima facie* case of obviousness, and the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application, including pending claims 1-31 and new claim 32, is therefore respectfully requested.

Applicant has included a check in the amount of \$250.00 in payment of new claim 32. In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,

A handwritten signature in black ink that reads "Russ Fowler" with a stylized flourish at the end.

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